

REMARKS

Claim 28 is added, and therefore claims 14 to 28 are pending in the present application.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for acknowledging the claim for foreign priority and for indicating that all certified copies of the priority documents have been received.

Claims 14, 17-20, 22-24, and 27 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,596,665 ("Kurashima").

To reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied art." (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

While the rejections may not be agreed with, to facilitate matters, claim 14 has been rewritten to better clarify the claimed subject matter.

Claim 14, as presented, is now more directed to the problem of the vibration stimulation of circuit substrates and the reduction of this vibration stimulation. In particular, claim 14, as presented, is to “device of a control unit of a motor vehicle”, and the feature of “a circuit substrate stimulated by vibration during operation” has been inserted. This feature is disclosed in the original specification on page one (stated object of providing “a secure holding of the special components in response to various vibrational stimulations”). Moreover, the feature of “static and dynamic stability” is supported, for instance, by the specification on page two. The feature of “onto which a circuit substrate having the special components fastened onto it is mounted in an electrically insulated manner at least over a partial surface” is further described by the feature “to which . . . is connected in a vibration-damping manner”.

The Kurishima reference is not relevant related art. Thus, the carrier designated as such by the Office Action under position 7, Figure 2, is not to be understood functionally as such, since a fixing part is involved which is provided to receive optical modules 5 located on the circuit substrate. In particular, it may also be seen in Figure 6 that fixing part 7 is used exclusively for fixing optical modules 5 that were inserted previously into housing cover 4. Neither the touching nor even a contact with circuit board 8 that was already inserted into the housing can be recognized or inferred from the description. Consequently, the fixing part is not a circuit board to which the circuit substrate is connected in a vibration-damping manner, as provided for in the context of the presently claimed subject matter.

In a rejection of claim 14, the Examiner asserts that Kurashima discloses the presence of a carrier, and the Examiner cites reference number 7 in Figure 2 of the Kurashima reference as support. According to the discussion in Kurashima, reference number 7 refers to the sleeve holder, a part used to hold a cylindrical sleeve in the cavity. See Kurashima, Col. 2, lines 20-22. The sleeve holder is not connected directly to a control unit, nor is the sleeve holder adhesively connected to the circuit substrate. Accordingly Kurashima does not disclose or suggest a carrier.

For at least the foregoing reasons, claim 14 and its dependent claims 17-20, 22-24 and 27 are allowable over Kurashima, and the anticipation rejection should be withdrawn.

Claims 15, 16, 25, and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kurashima in view of U.S. Patent No. 5,107,404 (“Tam”).

Claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kurashima in view of U.S. Patent Application No. 2003/0086245 (“Wakabayashi”).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claims 15, 16, 21, 25, and 26 depend from claim 14, as presented, and they are therefore allowable for essentially the same reasons as claim 14, as presented, since the secondary references do not cure -- and are not asserted to cure -- the critical deficiencies of the primary reference as to claim 14, as presented.

As to the Tam reference, it concerns a circuit board of a telephone system made up of a circuit board, an aluminum frame screwed to it and a cover and floor part that is in each case applied on one side of this arrangement. Such a telephone system, during

operation, is not exposed to any dynamic forces, and thus not to any vibrations. In contrast, the presently claimed subject matter involves a preparation of a control device, in particular, of a motor vehicle, having a circuit substrate that is stimulated to vibrations during operation.

Still further, the Tam reference concerns providing optimal EMV protection and good access to the circuit substrates. This is assertedly implemented by the aluminum frames screwed onto the circuit substrate, so that an optimal screening is attainable (by an internal bracing), even of individual circuit areas as to one another. The accessibility to the circuit substrate is brought about by lifting off the cover or floor part through the aluminum frame.

In contrast, the presently claimed subject matter provides for reducing the transfer of vibration stimulation to the circuit substrate. This is particularly relevant for control units of motor vehicles in which strong vibrations are introduced to the circuit substrate during driving. These can then lead to damage of the components fastened to the circuit substrate. Vibration damping of the circuit substrate is achieved, according to the presently claimed subject matter, by connecting the circuit substrate to a carrier. Because of such a connection, static and dynamic stability of the circuit substrate is achieved, so as to damp the vibration stimulation of the circuit substrate.

One cannot infer from the applied references any disclosure or suggestions on providing a carrier according to the presently claimed subject matter inside a device of a control unit, especially for a "vibration-stimulated circuit substrate during operation". Accordingly, Kurashima and Tam, whether taken alone or combined, do not disclose the feature of connecting a vibration-stimulated circuit substrate within a device of a control unit to a carrier, especially so as to achieve a static and dynamic stability, so that a vibration-damping connection is present. The vibration problem of a circuit substrate with a result of damage to components fastened to the circuit substrate is not even discussed in the Tam reference.

Accordingly, claims 15, 16, 25, and 26 are allowable.

As to claim 21, it depends from claim 14, as presented, and it is therefore allowable for essentially the same reasons as claim 14, as presented, since the Wakabayashi reference does not cure -- and is not asserted to cure -- the critical deficiencies of the primary reference.

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

Accordingly, claims 15, 16, 21, 25, and 26 are allowable.

New claim 28 does not add any new matter and is supported by the present application. Claim 28 depends from claim 14, as presented, and it is therefore allowable for the same reasons as claim 14.

Accordingly, claims 14 to 28 are allowable.

CONCLUSION

It is therefore respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections and objections be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.


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